



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Confirmation No.: 1893

Jyotirmoy PAUL, et al.

Group Art Unit: 2176

Serial No.: 09/631,884

Examiner: Nathan HILLERY

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Title: MULTI-DEVICE SUPPORT FOR MOBILE APPLICATIONS USING XML

Mail Stop Appeal Brief – Patents

Commissioner for Patents

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REPLY BRIEF

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed on
November 2, 2005.

I. INTRODUCTION

The Appellants believe that the following comments will be helpful to the Board of Patent Appeals and Interferences in making its decision regarding the application referenced above.

II. GROUNDS OF REJECTION OF CLAIMS 4 AND 17

The Final Office Action of April 14, 2005 rejected Claims 4 and 17 under 35 U.S.C. § 103(a) as allegedly unpatentable over BAYEH in view of BOAG, further in view of

MONDAY, and further in view of HILL as these references were applied to Claims 1-3, 6-10, 12-16, 19-20, and 23-28, and further in view of Karanjit Siyan, *NetWare TCP/IP and NFS*, New Riders Publishing 1994, pp. 11, 94, 103 (“SIYAN”).

Claims 4 and 17 are dependent upon independent Claims 1 and 14, respectively, and thus include each and every feature of their corresponding independent claim. Furthermore, as argued on page 12 of the Appellants’ Appeal Brief, in rejecting Claims 4 and 17 the Office Action relies explicitly on BAYEH, BOAG, MONDAY, and HILL, and not on SIYAN, to show the features discussed in the Appellants’ Appeal Brief with respect to Claims 1 and 14. Because SIYAN does not teach or suggest the subject matter of Claims 1 and 14, any combination of SIYAN with the other four references necessarily fails to teach the complete combination recited in Claims 4 and 17.

For this reason, in the section titled “CONCLUSION AND PRAYER FOR RELIEF” of their Appeal Brief, the Appellants respectfully requested that the rejections of Claims 4 and 17 be reversed if the Honorable Board finds that independent Claims 1 and 14 are patentable over BAYEH, BOAG, MONDAY, and HILL.

III. ARGUMENTS IN RESPONSE TO THE EXAMINER’S ANSWER

- A. **There is no suggestion or motivation to combine BAYEH with BOAG, MONDAY, and HILL because the combination of BAYEH with BOAG (1) would change the principle of operation of BAYEH, and (2) would render BAYEH unsatisfactory for its intended purpose.**

In the Examiner’s Answer, the Office has expressed the opinion that the Appellants’ arguments regarding the lack of suggestion or motivation to combine BAYEH with BOAG amount to arguing an inability to bodily incorporate the systems described in these

references. This opinion of the Office is a gross misinterpretation of the Appellant's arguments. It is respectfully submitted that in their Appeal Brief the Appellants have specifically identified a principle of operation of BAYEH and have shown why modifying BAYEH according to the teachings of BOAG would violate this principle. Further, in their Appeal Brief the Appellants have shown why a modification of BAYEH according to the teachings of BOAG would render BAYEH unsatisfactory for its intended purpose. Thus, under the holdings of *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959), and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984), there is no suggestion or motivation to modify BAYEH according to the teachings of BOAG, and for this reason the cited references are not sufficient to render any of Claims 1-3, 6-10, 12-16, 19-20, and 23-28 *prima facie* obvious.

The arguments advanced by the Office in the Examiner's Answer seem to be based on the proposition that, in determining whether there is a suggestion or motivation to combine BAYEH with BOAG, one of ordinary skill in the art must look ONLY to the passages and sections cited by the Office and must disregard everything else that is taught by BAYEH and BOAG. (See Examiner's Answer, page 18, arguing that "... the specific sections or passages of Bayeh cited by the Appellant is not used in the rationale of the above rejection(s) of the claims under 35 U.S.C. § 103(a).") This proposition of the Office, however, is contrary to the current law and the holdings of cases regarding obviousness under 35 U.S.C. § 103(a). For example, as stated in *In re Fulton*, 391 F.3d 1195, 1199, 73 USPQ2d 1141, 144 (Fed. Cir. 2004), the proper inquiry for determining whether there is a suggestion or motivation to combine prior references is "whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness of making the

combination.” Thus, in making an obviousness rejection, the Office is not allowed to cherry-pick the passages from the prior art references that it likes and to disregard everything else that may be taught by these references.

Further, in the Examiner’s Answer the Office proposes a modification of BAYEH in which BAYEH’s rendering servlet is completely replaced by the mechanisms for applying stylesheets either at the client or at the server as taught by BOAG. (See Examiner’s Answer, page 19, stating that “[t]he application of the stylesheet taught by Boag can be used as a ‘rendering servlet’ on the XML data stream taught by BAYEH as would have been well-known to one of ordinary skill in the art at the time of the invention.”) It is respectfully submitted that the prior art lacks the requisite suggestion or motivation to make this proposed modification of BAYEH for at least two reasons.

First, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the **desirability** of the combination. See *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis added.) It is respectfully submitted that BAYEH already provides a rendering servlet that is capable of parsing the XML stream received from the data servlet in an optimal manner. Thus, there is absolutely no need to replace BAYEH’s rendering servlet with another component that performs similar functionality. Further, in col. 9, lines 19-24, BAYEH expressly states that formatting the XML data stream at the rendering servlet localizes all necessary changes to code running on servers, thus maximizing the advantages of BAYEH’s processing model. Thus, BAYEH not only does NOT teach the desirability of the modification proposed by the Office, but also expressly teaches that formatting the XML data

stream at the client browser (as per the teachings of BOAG) would in fact be disadvantageous.

Second, a statement that the proposed modifications of the prior art references would have been well within the ordinary skill of the art at the time the invention was made is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); MPEP § 2143.01, Section IV. In the Examiner's Answer, the Office asserts that one of ordinary skill in the art would have known that the application of style sheets as taught by BOAG can be used to replace the rendering servlet in BAYEH's system. However, as discussed above, there is nothing in the cited references to suggest that it is desirable to modify BAYEH in such a way. To the contrary, if anything, BAYEH teaches that the application of stylesheets as taught by BOAG (which would include applying stylesheets at the client browser) is undesirable and disadvantageous. For the above reasons, it is respectfully submitted that the cited prior art lacks the requisite suggestion or motivation to make the modification of BAYEH according to the teachings of BOAG as proposed by the Office.

Finally, the Office insists that it is not limited to the preferred embodiment described in BAYEH. Specifically, on page 19 of the Examiner's Answer, the Office states:

Bayeh teaches the general functionality of a rendering servlet, which can be used differently in other embodiments of Bayeh's invention and/or in combination with **other teachings** such as those of Boag of **which one of ordinary skill in the art** at the time of the invention **would be well aware**. **The Office is not solely limited to the preferred embodiment of the prior art and does not rely on those teachings in the 103(a) rejection(s) outline above.** (Emphasis added.)

Thus, the Office argues that the teachings known in the art at the time of the present invention (such as the teaching of BOAG) would have suggested the combination of BAYEH with BOAG. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Further, the Office insists that it is not limited to the preferred embodiment of BAYEH. However, the Office does not cite a passage from, or otherwise point to an alternative embodiment of BAYEH that supports its position. It is respectfully submitted that nothing in BAYEH describes an embodiment without a component performing the functionality of a rendering servlet **on the server** or an embodiment where a component **on the client** performs the formatting of an XML data stream. The alternative embodiments described in BAYEH refer generally to combining the functionalities of the data servlet and the rendering servlet in one or more server-side modules (col. 6, line 67 – col. 7, line 10; col. 7, lines 18-25), and to using stylesheets different from XSL to format the XML data stream into an HTML stream (col. 9, lines 25-29; col. 12, lines 16-27). It is only ironic that the Office wants to base the rejections of the present claims on embodiments that are not described or even suggested by BAYEH while at the same time asserting that the Appellants are not allowed to prove lack of suggestion or motivation to combine by using passages from BAYEH other than those cited by the Office.

For the above reasons, it is respectfully submitted that there is no suggestion or motivation to combine BAYEH with BOAG. In the absence of such suggestion or motivation to combine, the Applicants respectfully submit that the rejections of Claims 1-3, 6-10, 12-16, 19-20, and 23-28 under 35 U.S.C. § 103(a) over BAYEH in view of BOAG,

further in view of MONDAY, and further in view of HILL cannot be sustained and must be reversed.

B. BAYEH, BOAG, MONDAY, and HILL, whether taken alone or in combination, do not teach or suggest all features of Claims 8-10.

Claim 8 includes the features of:

...
wherein **a plurality of mark-up languages are each associated with one or more client device types** of a plurality of client device types;
...
selecting, based on a client device type to which the output is to be sent, **a second mark-up language of said plurality of mark-up languages** that is different than said first mark-up language;
converting the first data to second data that conforms to the second mark-up language; and
sending the second data to the client.
...

Thus, in Claim 8 a second mark-up language is selected from a plurality of mark-up languages based on the type of the client device to which the output is to be sent, the first data is converted to second data that conforms to the selected second mark-up language, and the second data (conforming to the second mark-up language) is sent to the client.

In the Examiner's Answer, the Office identifies the plurality of mark-up languages as HTML, WML, etc., and states that stylesheet languages may be used for transforming documents from one markup language to another. Further, the Office asserts that the statement in the Abstract of BOAG that "[i]f the client device cannot apply style sheets, then they are applied at the server, and the resulting document is sent to the client" is equivalent to the feature of Claim 8 of **selecting, based on a client device type to which the output is to be sent, a second mark-up language of said plurality of mark-up languages**. This assertion is incorrect.

In col. 4, lines 30-36, BOAG teaches that its technique comprises:

selecting one or more style sheets to transform a particular input document;
determining whether a client device is capable of applying the selected style sheets; applying the selected style sheets at the client device when the determining has a positive result; and applying the selected style sheets at a server when the determining has a negative result. (Emphasis added.)

Thus, BOAG expressly teaches that a determination is made as to whether a client is capable of applying pre-selected stylesheets to a particular input document. If the client is capable of applying the pre-selected stylesheets, then the client applies these stylesheets to the particular document; if the client is not capable of applying the pre-selected stylesheets, then the server applies these stylesheets to the particular document.

In BOAG's technique, however, the determination of whether the client is capable of applying some pre-selected stylesheets is NOT a selection of a mark-up language that is associated with the client device type and that is based on the client device type, as featured in Claim 8. For example, nothing in BOAG teaches or suggests that any determination is made as to the TYPE of the client, such as, for example, a determination of whether the client is a hand-held device that provides built-in JVM and support for running Java applets. What BOAG teaches is making a **binary** determination of whether the client **can or cannot** apply a particular pre-selected stylesheet. This is significant since such a binary determination does not provide enough information to select or determine a particular mark-up language, from among a plurality of mark-up languages, that may be associated with the client. Further, contrary to the assertion in the Examiner's Answer, nothing in BOAG describes, teaches, or suggests that determining that a client is NOT capable of applying a pre-selected style sheet has anything to do with SELECTING a particular markup language (such as, for example, HTML or WML) that may be associated with that client.

In contrast, Claim 8 comprises at least the features of: (1) a plurality of mark-up languages that are each associated with one or more client device types; (2) selecting, based on a client device type to which the output is to be sent, a second mark-up language of said plurality of mark-up languages; (3) converting a first data to second data that conforms to the selected second mark-up language; and (4) sending the second data to the client.

For the reasons given above, it is respectfully submitted that BOAG does not describe at least the feature of Claim 8 of selecting, based on a client device type to which the output is to be sent, a second mark-up language of said plurality of mark-up languages. Further, the Office relies explicitly on BOAG, and not on BAYEH, MONDAY, or HILL to show a prior disclosure of this feature of Claim 8. Thus, any combination of BOAG with the other three references necessarily fails to teach all the features of Claim 8, as well as all the features of Claims 9-10 which depend from Claim 8.

Thus, the Applicants respectfully submit that Claims 8-10 are patentable under 35 U.S.C. § 103(a) over BAYEH in view of BOAG, further in view of MONDAY, and further in view of HILL.

IV. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, it is respectfully submitted that after consideration of the Examiner's Answer, the rejection of Claims 1-3, 6-10, 12-16, 19-20, and 23-28 under 35 U.S.C. § 103(a) still lacks the requisite factual and legal bases.

The Appellants therefore respectfully request that the Honorable Board reverse the rejection of Claims 1-3, 6-10, 12-16, 19-20, and 23-28 under 35 U.S.C. § 103(a) over BAYEH in view of BOAG, further in view of MONDAY, and further in view of HILL.

Further, for the reasons stated above, the Appellants also respectfully request that the Honorable Board reverse the rejection of Claims 4 and 17 under 35 U.S.C. § 103(a) over BAYEH in view of BOAG, further in view of MONDAY, further in view of HILL, and further in view of SIYAN.

Respectfully submitted,

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